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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,510	04/18/2001	Kenneth Kiron	3001 P 013	8885

7590 07/05/2006

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EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,510	KIRON ET AL.	
	Examiner	Art Unit	
	Lalita M. Hamilton	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53 and 90-158 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53 and 90-158 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04142003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 53 and 90-158 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,088,685. Although the conflicting claims are not identical, they are not patentably distinct from each other, because claims 53 and 90-158 of pending application 09/837,510 are the same method for intended use as claims 1-34 of U.S. Patent No. 6,088,685. The additional limitation disclosed by application 09/837,510 is "trading the outstanding shares of the fund on an exchange at a real time determined price related to the securities comprising the subgroup", while all the other limitations in claims 53 and 90-158 are the same as claims 1-34 of U.S. Patent No. 6,088,685.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53 and 90-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien (5,101,353) in view of Cristofich (5,671,363).

Lupien discloses a method of automated securities markets comprising identifying a collection of securities (col.3, lines 15-30); identifying a group of securities comprising a subset of the collection of securities (col.3, lines 45-65); separating the group of securities into a subgroup that satisfy an investment objective and comprising a subset of the group of securities (col.4, lines 5-41); creating an open end fund having a number of outstanding shares and comprising of the securities within the subgroup (col.4, lines 5-57); changing the securities comprising the group and changing the securities comprising the subgroup in response to the changing of the securities comprising the group (col.4, lines 5-57); the open end fund is not a unit investment trust (col.4, lines 5-57); listing the outstanding shares on an exchange (col.2, line 60 to col.3, line 15); listing on an exchange a derivative having a price related to the real time determined price (col.3, lines 15-45); calculating overall positions of shareholders of the outstanding shares (col.3, lines 15-45); electronically trading the outstanding shares (col.2, line 60 to col.3, line 15); the securities within the portfolio being weighted and the portfolio being changeable in response to a change in the identified group (col.4, lines

Art Unit: 3624

1-40); and trading the outstanding shares of the fund on an exchange at a price related to the price of the securities within the portfolio (col.4, lines 1-40). Regarding claims 90-99, 109-118, 120-130, 133-141, and 145-153, the investment objective may be any objective that the user desires to achieve. Lupien does not disclose trading outstanding shares of the fund on an exchange at a real time determined price related to the securities comprising the subgroup or outputting an indication of the real time determined price in a humanly readable format. Cristofich teaches a stock option system comprising real time input mechanisms, which the examiner is interpreting as trading outstanding shares of the fund on an exchange at a real time determined price related to the securities comprising the subgroup and outputting an indication of the real time determined price in a humanly readable format (col.3, lines 15-27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate . Lupien does not disclose trading outstanding shares of the fund on an exchange at a real time determined price related to the securities comprising the subgroup as outputting an indication of the real time determined price in a humanly readable format, as suggested by Cristofich into the invention disclosed by Lupien, to provide real time output on an exchange in order to present accurate data at the time requested.

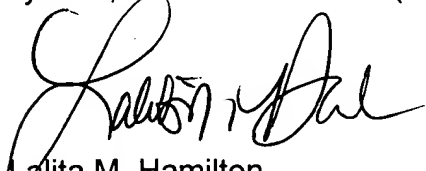
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lalita M. Hamilton
Primary Examiner, 3624